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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/057,406	04/08/98	WERENICZ	H 94-36-3-US-D

HB FULLER CO
PATENT DEPARTMENT
P.O. BOX 64683
ST PAUL MN 55164-0683

IM22/0731

EXAMINER

AFTERGUT, J

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/057,406

Applicant(s)

WERENICZ ET AL.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12,33-36,38-42,44 and 46-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12,33-36,38-42,44 and 46-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 2-6, 8-12, 33-36, 38-42, 44, and 46-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maletsky et al '928 in view of Cardinal (the article entitled "A New Cost Effective Method to Confer Tailored Breathability and Liquid Barrier Properties to Nonowovens") for the same reasons as presented in paper no. 28, paragraph 3.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with E.P. 295,694 for the same reasons as expressed in paper no 28, paragraph 4.

4. Claims 47-51, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with the applicant's admitted prior art for the same reasons as expressed in paper no. 28, paragraph 5.

Response to Arguments

5. Applicant's arguments filed 7-16-01 have been fully considered but they are not persuasive.

The applicant is initially advised that the amendments dated 2-13, 2-14, and 3-9-01 have all been canceled and that the claims have been amended according to the instructions provided in the 7-16-01 amendment. The applicant also has submitted arguments relating to the previously made rejections, however the rejections (Cardinal et al in view of Mormon et al optionally further taken with Bunnelle et al) has been withdrawn and as a result there is no need to comment further regarding the same.

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Regarding the rejection as set forth above in paragraph 2, the applicant begins to address the same on page 9 of the response. The applicant argues the in order to establish obviousness based upon a proposed combination there must be some teaching, suggestion, or motivation in the prior art for making the combination. The applicant argues that there simply is simply no teaching, suggestion or motivation to combine the teachings of the references. More specifically, the applicant argues that Maletsky taught an unknown coating method for making the continuous film out of the specific composition. The applicant is advised that: (1) Maletsky clearly suggested one would have performed some form of extrusion coating technique (see example 2, column 6, lines 42-46; (2) the purpose of the film coating in Maletsky was to provide a breathable film which was impervious to water and/or moisture and the reference to Cardinal was intent upon providing a breathable film which likewise was a moisture barrier (the references are clearly from the same field of endeavor); (3) the ordinary artisan would have been expected to employ conventional coating techniques which were employed to apply thin films to nonwovens and such was suggested by Cardinal (in other words, the reference to Maletsky suggested one would have bonded the film to the nonwoven material and that the same was coated thereon in an extrusion operation, one skilled in the art would have certainly been expected to look to the coating art via extrusion where thin films were coated upon nonwoven substrates for useful techniques for applying the coatings in Maletsky), and; (4) a rejection under 35 USC 103(a) is not based upon absolute predictability but rather upon whether one would have expected reasonable success when combining the references (here one would have expected that the extrusion coating operation of Cardinal would have been a suitable coating technique via extrusion and would have attained the desired function of applying the thin film of Maletsky to

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the nonwoven webs in the manufacture of a breathable laminate which had high moisture and water impermeability).

The applicant argues that Maletsky does not teach the method used to coat the film upon the nonwoven. The applicant is advised that the reference suggested that one skilled in the art would have performed an extrusion operation to apply the film upon the nonwoven. See the portion of Maletsky referred to above. The reference to Cardinal suggested an extrusion operation to apply the film upon the nonwoven. There is no reason to believe one would have been led away from looking to the techniques of Cardinal for applying the film in Maletsky.

The applicant argues that the reference to Maletsky failed to teach that the extruder employed was spaced from the substrate. This is correct. The reference did not elaborate on the relative local of the extruder outlet relative to the substrate being coated with the film. The reference to Cardinal suggested one skilled in the art would have understood that the extruded film would have been spaced from the substrate. The reference made it clear that such a coating operation was well known in the art and it certainly would have been within the purview of the ordinary artisan to look to the teachings of Cardinal for the same for the reasons identified above. The applicant is advised that one cannot show nonobviousness by attacking references individually where combination of references have been applied against the claims. The applicant also noted that a discontinuous coating would have resulted in Maletsky when one employed polyethylene, ethylene/vinyl acetate copolymers, block copolymers of styrene and butadiene styrene and isoprene. The applicant is advised that the portion of the reference referred to is taken out of context. The reference clearly suggested that a pinhole free coating was

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provided. The portion referred to by applicant merely is describing a control mechanism to attain a pinhole free film of the specified thickness.

Regarding Cardinal, the applicant argues that Cardinal teaches viscosities outside the disclosure of Maletsky and disclosed the use of a different polymeric composition for the processing therein. The applicant is advised that the rejection is not based upon the use of the composition of Cardinal, but rather upon the conventional extrusion processes disclosed by Cardinal which would have been useful with the compositions of Maletsky to form a breathable, water impervious laminate. The applicant somehow thinks that because Cardinal suggested a different viscosity that this taught away from the combination. This is not understood. The reason for looking at Cardinal was to suggest that one skilled in the art at the time the invention was made knew how to suspend the film from an extruder prior to coating the film upon a substrate in the manufacture of a breathable, water impervious laminate (for which Maletsky desired to produce). Clearly, one would have been motivated to look to Cardinal for the conventional extruding processes useful for forming the laminate.

Applicant additionally argues that the film in Maletsky was not a continuous, pinhole free film. The applicant is referred to column 5, lines 17-40, column 3, lines 53-column 4, line 1, for example. Clearly, the reference envisioned the formation of a pinhole free film upon the nonwoven in the manufacture of a laminate for a disposable diaper. Such would have provided a moisture barrier.

The applicant argues that Maletsky did not disclose the specific viscosities measured at the specified frequencies. It should be noted that Maletsky employed the same polymer compositions as that of applicant. One would have expected that the same polymer compositions

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would have had the same viscosities (as such is an intrinsic property of the polymeric material selected for the operation).

The applicant argues that the reference to Cardinal taught a curtain coating operation. The applicant is advised that the claims at hand do not distinguish the coating techniques of Cardinal from that claimed and thus the claims at hand are not commensurate in scope with the arguments presented.

Regarding the reference to E.P. '694, the applicant argues the reference to E.P. '694 failed to teach coating with a material having the specified viscosity and that there is no motivation to combine the teachings contained in E.P. '694 with the other references. These arguments are respectfully traversed. To begin with, the reference to Maletsky suggested the specified viscosity of material as well as the same plastic material for the extrusion operation. E.P. '694 was added for the same reasons the Cardinal was added, i.e. to show that those skilled in the art would have known how to extrude the materials to attain a film of the plastic material and join the film to a substrate in the manufacture of a breathable laminate. The reference did evidence the disposing of the substrate in a vertical position as claimed. As noted above, one cannot show nonobviousness by attacking references individually where combinations of references have been applied against the claims. The applicant is advised that one skilled in the art would have looked at E.P. '694 and considered the same relevant to the question of what kind of extrusion processing would have been performed to apply the films of Maletsky and thus the reference would have been viewed as analogous to the claimed invention. Whether one applied the extruded film to the substrate in a vertical or horizontal position would have been within the purview of the ordinary artisan lacking a showing of new or unexpected results. Note that one

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skilled in the art would have readily been able to determine the benefits and disadvantages of both application techniques and it certainly would have been within the skill level of the ordinary artisan to select one of the two techniques based upon their known advantages and disadvantages. The motivation to combine the teachings is that the techniques of E.P. '694 would have been viewed as functionally equivalent alternate expedient for the techniques of Cardinal and therefore would have been employed (note that the functionally equivalent technique was from a common art, i.e. the formation of a breathable laminate which was water and/or moisture impermeable).

Regarding the admitted prior art, the applicant merely suggested (in the response to the earlier rejection, note that no remarks regarding the admitted prior art were made regarding the last prior art rejection submitted to applicant) that the admitted prior art did not cure the deficiencies of the references to Maletsky and Cardinal. As discussed in detail above, there are no deficiencies in the prima facie case presented by Maletsky as modified by Cardinal (actually, the reference is not modifying Maletsky but it is evidencing that those of ordinary skill in the art would have known how to extrusion coat to form the breathable laminate wherein such coating included non-contact coating operation such as those depicted in Figure 3 of Cardinal). The applicant does not address (otherwise) the teachings of the admitted prior art and it is therefore believed that applicant agrees with the Office interpretation of the same.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
July 31, 2001